

## **REMARKS**

Claims 1-7, 9, 11, and 20-29 were pending in the application. The Examiner has rejected all claims. Claims 1-6, and 11 have been cancelled. New claims 30-36 have been added.

### **Claim Identifier Missing**

The Examiner has pointed out that “(c)laims 2-9 and 11 are missing status identifier.” The listing of the claims reflects a correction of any omission.

### **Rejections under 35 U.S.C. § 112**

The Examiner has rejected claims 25-29 “under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.” Office Action, page 2. Applicant traverses this rejection.

The Examiner has stated that the “expression ‘said firm support layer is significantly more rigid than said mark retaining layer’ is new matter.” Office Action, page 2. The specification states that a “sheet of durable resilient material 18, such as *polycarbonate plastic*, provides a firm support means. However other durable, resilient materials may also be used, such as composites, rubber, plastics, *wood, metal*, or the like.” Specification, page 8, lines 14-18, emphasis added. The specification also states that a “mark retaining surface means 20, for recording an impression from contact with a golf club head is preferably an impression retaining *paper* such as no carbon required *paper* (NCR) wax, *carbon paper* or the like. Specification, page 8 line 25-page 9 line 3, emphasis added. Thus, the specification has clearly described materials “wherein said firm support layer is significantly more rigid than said mark retaining layer”, as recited in claim 25. In addition, an original claim described a

base element which includes “a sheet of polycarbonate plastic.” Specification, claim 6. Another original claim described a mark retaining surface means comprising “a sheet of carbon paper”. Specification, claim 9.

Applicant asserts that claim 25, and its dependent claims 26-29, have sufficient and full basis in the specification as filed. Applicant requests withdrawal of this rejection.

#### **Rejections under 35 U.S.C. § 102(b)**

The Examiner rejected Claims 1, 2, and 20 “under 35 U.S.C. 102(b) as being anticipated by Perrine (U.S. Patent 5,984,802).” Office Action, page 3.

Claims 1 and 2 have been cancelled.

With regard to claim 20, the Examiner has stated that “Perrine discloses the invention as recited above and in column 6, lines 48 it is stated that the retaining surface is **fastened** to the bottom element **indicating that this surface is removable.**” Office Action, page 3, emphasis added. Applicant strongly asserts that a disclosure as to fastening is not a disclosure as to being removable, and is certainly not a disclosure as to being “easily removed and replaced”, as recited in claim 20. Applicant has consulted the dictionary and finds no linkage between the terms “fastened” and “easily removable and replaceable”. In addition, Applicant has pointed out in a previous paper that in the context of the cited reference no such inference should be drawn. Applicant repeats this argument here for clarity and for emphasis:

*Perrine's* layer 112 in Figure 6, like its layer 12 in Figure 1, is not meant to be easily removed. It is disclosed as being attached by screws (Col. 5, ln 34) for the layer 12 and, for the 112, “a strip 150 ... may be thermally or adhesively bonded to the under surface of the top sheet 112”. In *Perrine*, the top sheet 112, like the layer 12, is not disclosed as coming off of the base 114 after assembly. And the strip 150 is bonded up into the top sheet; it appears to be permanently attached to the top sheet (note thermal bond reference, Col. 6, ln 55) which itself is not easily removable. Nowhere does *Perrine* disclose easy removal, of the “mark retaining surface means”, for example for

later comparison to other such sheets. The present invention, as seen in the Figures, and as described on page 10, lines 21-23, allows for such removal and later comparison. Also the present application discloses the attachment of the "mark retaining surface means" using hook and loop fastening elements (Velcro), understood to be easily removable. Thus, *Perrine* does not disclose a mark retaining surface, "wherein said mark retaining surface means is adapted to be easily removed and replaced", as recited in claim 20.

Applicant requests withdrawal of the rejection with regard to claim 20.

The Examiner rejected Claims 4, 5, and 22 "under 35 U.S.C. 102(b) as being anticipated by *Perrine*." Office Action, page 3.

Claims 4 and 5 have been cancelled. Claim 22 is allowable at least for the reason of its dependence on claim 20, which was discussed above.

The Examiner rejected Claim 11 "under 35 U.S.C. 102(b) as being anticipated by *Perrine*." Office Action, page 4. Claim 11 has been cancelled.

#### **Claim Rejections -35 U.S.C. § 103(a): Obviousness**

The Examiner has rejected Claims 3 and 21 "under 35 U.S.C. 103(a) as being unpatentable over *Perrine*." Office Action, page 4. Claim 3 has been cancelled. Claim 21 is allowable at least for the reason of its dependence on claim 20, which was discussed above.

The Examiner has rejected claims 6, 23, and 24 "under 35 U.S.C. 103(a) as being unpatentable over *Perrine*." Office Action, page 5. Claim 6 has been cancelled. Claims 23 and 24 are allowable for at least the reason of their dependence on claim 20, which was discussed above.

The Examiner has rejected claim 7 "under 35 U.S.C. 103(a) as being unpatentable over *Perrine* in view of Manheck (US patent No. 3,754,764)." Office Action, page 5.

The Examiner has stated that it "would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a no carbon paper as taught by

Manheck in the Perrine device in order to register the actual path of a golf club's head when a club head is in contact with a top sheet as a player swings his golf club." Office Action, pages 5-6. But *Manheck* and *Perrine* are geared towards different uses. *Manheck* is geared towards "capturing the exact impact point of a golf ball on the face of the club". *Manheck*, Col 1, lns. 41-43. Although many objects of the invention are listed in *Perrine*, the object of *Manheck* is not one of them. The impact zone of the ball to the club, as in *Manheck*, is a distinctly different type of information than the impact of the club to the ground (which involves the club swing path), as in the present invention. Because the object of *Manheck* is different than that of the present invention, and because the object of *Manheck* and *Perrine* are different, there is simply no motivation to combine the elements of *Manheck* and *Perrine*, as suggested by the Examiner. In addition, the invention in *Manheck* requires the use of a ball, by its very nature. This stands in contrast to the present invention. Once again, Applicant asserts that there is simply no motivation to combine the references cited by the Examiner for the foregoing reasons. Applicant respectfully requests withdrawal of the rejection.

The Examiner has rejected claim 9 "under 35 U.S.C. 103(a) as being unpatentable over Perrine in view of Grossman (US patent No. 2,660,436)." Office Action, page 6.

Claim 9 is allowable at least for the same reasons presented above with regard to claim 7.

The Examiner has rejected claim 2 "under 35 U.S.C. 103(a) as being unpatentable over Perrine in view of Miller (US patent No. 5,028,052)." Office Action, page 6. Claim 2 has been cancelled.

The Examiner has rejected claims 25-29 "under 35 U.S.C. 103(a) as being unpatentable over Perrine." Office Action, page 7. Applicant traverses this rejection. With regard to claim 25, the Examiner states that "Perrine does not indicate wherein the support layer is more rigid than the mark retaining layer." Office Action, page 7. The Examiner

states further that “it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide a variety type of support layer...” One “would have expected Applicant’s invention to perform well with the support layer as taught by Perrine.” Office Action, pages 7-8.

With regard to claim 25, Applicant asserts that 1) it would not have been a matter of obvious design choice to alter Perrine to a condition wherein “said firm support layer is significantly more rigid than said mark retaining layer”, as recited in claim 25, as Perrine has a stated purpose and function that explicitly teaches away from that choice, and 2) there is absolutely no basis in law for a rejection based upon Examiner’s assertion that Applicant’s invention would perform well with the layer as taught by Perrine. The Examiner’s role is to examine claims, and not to redesign one of the Applicant’s embodiments **to a condition other than claimed** and then to draw conclusions based on these non-claimed embodiments.

*Perrine* discloses that top sheet 12 (referred to later as 112 in Figure 6) “is relatively compliant/non-rigid.” *Perrine*, Col. 3, ln. 58. The Examiner has used this sheet to illustrate the mark retaining layer of claim 1, and referred to this when addressing claim 25. The Examiner has used item 150 to illustrate the firm support layer. Yet *Perrine* states that this is a “strip 150 of the *same* or chemically compatible, plastic material, with a similar thickness and length. *Perrine*, Col. 6, lns. 54-55, emphasis added. There is no motivation to modify either of the layers in *Perrine*. In fact, “the respective properties of the top sheet 12 and the bottom pad 14 together enable the whole mat 10 to function.” *Perrine*, Col. 5, lns. 6-8. Thus, any modification of either of these layers of *Perrine* is discouraged.

Applicant requests withdrawal of this rejection with regard to claim 25. Claims 26-29 are allowable at least for the reason of their dependence on claim 25. Applicant requests withdrawal of the rejections of claims 26-29.

**New Claims**

New claims 30-36 are well supported in the specification and add no new matter.

**CONCLUSION**

For the above reasons, Applicants respectfully request reconsideration and allowance of all pending claims. Should the Examiner have any questions concerning this response, the Examiner is invited to call Michael Guth at (831) 462-8270.

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ED 328016627 US

Respectfully submitted,

*Michael Guth*

Michael A. Guth  
Attorney for Applicant  
Reg. No. 45,983